

### **REMARKS**

This Response is submitted in response to the Advisory Action of August 15, 2007 and the Final Office Action of March 5, 2007. Claims 1-17 and 23-46 are pending. Claims 1-17 and 23-46 are canceled and Claims 47-66 are added by this response. No new matter is added by this response. A Request for Continued Examination are submitted herewith. The Commissioner is hereby authorized to charge deposit account 02-1818 for any fees which are due and owing.

#### **35 U.S.C. 112 Rejections**

Claims 45 and 46 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. In particular, the Office Action stated that the specification does not describe scanning barcodes twice to provoke a battle. Applicants respectfully disagree. Fig. 6 clearly shows that when an monster is scanned and determined to be an incompatible monster at step 645, it is determined at step 660 whether this is the first scanning of the incompatible monster. If it is the first scanning, the monster explodes at step 665. If it is not the first scanning, due to the fact that a scanning has taken place, it must be at least a second scanning. In an embodiment operating in accordance with Fig. 6, a battle sequence is provoked at step 670 by this second (or higher) scan.

The Advisory Action states that there is no mention of scanning twice in paragraphs [0071] and [0072]. However, it is respectfully submitted that an explicit mention of scanning twice is not required at least because one of ordinary skill in the art would have understood at least upon viewing Fig. 6 that paragraphs [0071] and [0072] describe at least the process as illustrated in Fig. 6, in which a second (or higher) scanning of an incompatible monster results in a battle sequence being provoked.

Further, it is respectfully submitted that at least the first sentence of paragraph [0072] ("In other embodiments, even if the incompatible monster has been scanned only once, the process continues to step 670 and a simulated battle with the incompatible monster will ensue.") implicitly mentions the fact that in some non-"other" embodiments, an incompatible monster must be scanned.

It is respectfully submitted that one of ordinary skill in the art would have understood from the originally filed specification that the inventors had, at the time the application was filed, possession of a gaming device including an electronic circuit operable to determine whether a

contest will be staged, wherein if game data is not compatible game data and a bar code was scanned twice, a contest will be staged.

Further, the Advisory Action states that under the KSR decision, the number of scans would be a matter of design choice that would be well within the level of ordinary skill. Applicants respectfully disagree. It is respectfully submitted that initiating a game or competition after a second scan of a data item, but not after a first scan of the data item is a clever, useful, novel and non-obvious feature.

However, Claims 45 and 46 have been canceled and new claims have been submitted for consideration.

### **35 U.S.C. 103(a) Rejections**

Claims 1-12, 14-15 and 30-34 were rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Publication No. JP 2000308,763 ("Ebisawa") in view of the Diablo video game from Blizzard Entertainment ("Diablo"). Claims 13, 16-17, 23-29 and 35-44 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ebisawa in view of Diablo in further view of U.S. Patent No. 5,971,855 ("Ng"). Applicants respectfully disagree.

Ebisawa discloses a handheld game in which a bar code reader scans bar codes to further the game. Bar codes can be associated with products and companies, and bar codes are associated with characters which can do battle. However, Ebisawa does not disclose or suggest groups or tribes of characters which are controllable by some user and do not engage their fellow group or tribe members in contests or battle. Further, the Office Action admits that "Ebisawa does not teach the division of characters into groups where members of the group do not attack each other." For at least these reasons, Applicants respectfully submit that Ebisawa does not disclose or suggest that the compatible game data is part of a set of game data, the set of game data including character data for a plurality of characters, wherein at least two of the plurality of characters are associated with a group, and wherein a third of the plurality of characters is not associated with the group, and wherein the at least two of the plurality of characters do not engage each other in battle, and wherein the at least two characters are controllable by at least one user as in Claim 1.

Diablo is a computer game in which the player's character searches through areas of the game world, encountering and doing battle with various monsters. The Office Action states that

the monsters in the monster group do not attack each other and only attack the player's character. However, the monsters in the monster group are not controllable by any user of the Diablo game. In response, the Office Action appears to rely upon a Wikipedia article to show that the Diablo game had an online version in which groups of characters under control of players band together and do not attack each other. Further, the Office Action supposes that a single player could "control multiple players" and "determine not to attack himself".

However, it is respectfully submitted that a Wikipedia article is an unreliable source and can not be used to support a rejection. Applicants previously submitted a Wikipedia article in which the site admits that "nothing" keeps someone from putting false or misleading information in articles and even goes so far as to state that school children should not use Wikipedia articles for school essays without checking the external sources. It should be noted that Applicants did not edit this article to include this information, but there is no mechanism of which Applicant is aware that would have prevented Applicant from doing so. It is respectfully submitted that if Wikipedia is too unreliable to use as a source in a school child's essay, it is also too unreliable to support a contention about features which are believed to have been present in a video game.

The Advisory Action states that Applicant presented "absolutely no evidence that this particular Wikipedia article contains false or misleading information" and that "Applicant has played Diabale and knows that there is an online version." Applicant respectfully disagrees. Applicant has submitted evidence showing that the Wikipedia article cannot be considered credible evidence. It is the Patent Office's burden to make a prima facie case for obviousness. Such a case must be based upon credible sources. Applicant has proven the Wikipedia article, by the site's own admission, to be incredible. For at least this reason, the Patent Office has not met its burden of showing a prima facie case of obviousness. Further, the Advisory Action's statement regarding Applicants' experience with and knowledge of an online version of Diablo is contested. It is respectfully submitted that the only evidence of record of an online version of Diabale is the incredible Wikipedia article.

Further, even if Diablo had an online version in which multiple players could band together, it is respectfully submitted that there is nothing to suggest that a single player could "control multiple players" as hypothesized by the Office Action.

However, the rejected claims have been canceled, and new claims have been submitted for consideration.

It is respectfully submitted for at least the above reasons, Applicants respectfully submit that Diablo does not disclose or suggest that the compatible game data is part of a set of game data, the set of game data including character data for a plurality of characters, wherein at least two of the plurality of characters are associated with a group, and wherein a third of the plurality of characters is not associated with the group, and wherein the at least two of the plurality of characters do not engage each other in battle, and wherein the at least two characters are controllable by at least one user as in Claim 1.

For at least these reasons, Applicants respectfully submit that Claim 1 and its dependent claims, are each patentably distinguished over Ebisawa in view of Diablo.

Ng discloses a game device which can communicate with a similar game device for interactive play between the two devices. However, similar to Ebisawa and Diablo, Ng does not disclose or suggest that the compatible game data is part of a set of game data, the set of game data including character data for a plurality of characters, wherein at least two of the plurality of characters are associated with a group, and wherein a third of the plurality of characters is not associated with the group, and wherein the at least two of the plurality of characters do not engage each other in battle, and wherein the at least two characters are controllable by at least one user as in Claim 1.

For at least these reasons, Applicants respectfully submit that Claim 1 and its dependent claims are each patentably distinguished over Ebisawa in view of Diablo in further view of Ng. For similar reasons, Applicants respectfully submit that Claims 23 and 29, and their respective dependent claims are each patentably distinguished over Ebisawa in view of Ng.

Further, with respect to Claim 45, none of Ebisawa, Diablo and Ng disclose or suggest an electronic circuit operable to determine whether a contest will be staged, wherein if the game data is not compatible game data and the bar code was scanned twice, the contest will be staged. For at least this reason, Applicants respectfully submit that Claim 45 is patentably distinguished over Ebisawa in view of Diablo in further view of Ng.

Further still, with respect to Claim 46, none of Ebisawa, Diablo and Ng disclose or suggest that if the game data is not compatible game data and the bar code is scanned only once,

the contest will not be staged. For at least this reason, Applicants respectfully submit that Claim 46 is patentably distinguished over Ebisawa in view of Diablo in further view of Ng.

However, the rejected claims have been canceled, and new claims have been submitted for consideration.

It is respectfully submitted for at least the above reasons, new claims 47-66 are each patentably distinguished from the art of record and are in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and Applicants respectfully request that a Notice of Allowance be issued. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the undersigned.

Respectfully submitted,  
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